

### REMARKS

This paper responds to the Office Action dated May 17, 2006.

Claim 98 is amended, no claims are canceled, and claims 166-174 are added; as a result, claims 98, 99, 108, and 166-174 are now pending in this application. The added claims are fully supported by the specification as originally filed. No new matter is believed to be proposed.

Applicant notes that the prior office action did not address pending claim 108. Applicant requests examination of claim 108 in the next action.

#### §103 Rejection of the Claims

Claims 98 and 99 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nemirofsky (U.S. Patent No. 5,594,493) in view of Bullock et al. (U.S. Patent No. 5,070,404). Claim 99 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nemirofsky (U.S. Patent No. 5,594,493) and Bullock et al. (U.S. Patent No. 5,070,404) as applied to claim 98 above, and further in view of Boggs et al. (U.S. Patent No. 4,789,371). Applicant respectfully traverses.

The references must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant can not find in either Nemirofsky or Bullock or Boggs, the features of “*receiving the auxiliary data directly from video signals from the display device on the hand-held device; comparing the auxiliary data against prestored data on the hand-held device to determine whether a data match was identified; enabling a prestored promotional opportunity within read only memory of the handheld device; successively illuminating an LED of the plurality of sequenced LEDs when the data match was identified to provide the visual indication of the promotional opportunity available to the user of the hand-held device, . . . ; and connecting the handheld device to a computer-compatible interface to utilize the promotional opportunity (italics added)*”. As applicant can not find all of the features recited in claim 98 in Nemirofsky or Bullock or Boggs, applicant requests allowance of claim 98 and its dependent claims 99 and 108.

Applicant further traverses this obviousness rejection based on the fact that Bullock teaches away from the presently claimed combination. A factor cutting against a finding of

motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Bullock describes enabling cue signals in the form of DTMF tones. See, col. 2, lines 45-50; and col. 6, lines 46-65. Bullock further describes “data pertaining to a coupon for money off of the purchase price of a product, such as a particular detergent, is periodically transmitted on an FM radio subcarrier and is received, decoded and stored by a receiver at the home of a user until the proper cue signal is transmitted along with a television commercial for the particular detergent” (col. 2, lines 51-57). Bullock further states “The device 40 includes an FM radio receiver 42 which is electrically connected to an FM antenna 44. In the presently preferred embodiment, the receiver 42 is a standard FM radio receiver which includes a detector (not shown) for detecting the subcarrier which contains the coupon data. . . . The output of the subcarrier detector portion of the receiver 42 is applied to a decoder or demodulator 46 which selectively detects the FSK tones which contain the coupon data and converts the tones back into a stream or series of digital logic signals. (col. 5, lines 59-64).” Thus Bullock teaches that the coupon data is broadcast as a tone signal (not a video signal) and then stored. Bullock further requires an enable signal to be broadcast, which is described as a DTMF tone signal. A DTMF signal is a dual-tone multi-frequency signal, commonly referred to as touch-tone in the telephone arts. Bullock teaches away as it does not disclose video or image signals as enable signals and it does not disclose prestored coupons. One of skill in the art would not look to Bullock to combine with Nemirofsky. Moreover, there is no reasonable expectation of success in combining Bullock with Nemirofsky.

Reconsideration and allowance of claims 98, 99, and 108 are requested.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 612-373-6900 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

17 Nov '06

By

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17<sup>th</sup> day of November 2006.

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